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P56525RE**IN THE DRAWINGS**

The following amendments to the original drawings of original patent No. US5,917,679 are proposed:

In Figure 4, reference numerals 135, 190 and 192 are added;

In Figure 5, reference numerals 135 190 and 192 are added and lead line extended from reference numeral 121 beyond the vertical line is deleted, and four lines touching the right hand vertical line are deleted;

In Figure 6, two figures are now separately labeled as Figure 6A and 6B, and reference numerals 100, 130, 150, 190, 192 are added, four lines in each figure which are touching the bottom line of the figures are deleted;

In Figure 7, reference numerals 190 and 192 are added, reference numeral 121 changed to 120, and a line appearing in element 100 is deleted;

In Figure 8, reference numerals 190 and 192 are added;

In Figure 9, reference numerals 190 and 192 are added;

In Figure 10, reference numerals 182, 190 and 192 are added, and a line appearing in element 182 is deleted;

In Figure 11, reference numerals 182, 190 and 192 are added, a line appearing in element 182 is deleted, and the gap appearing near reference numeral 133 is closed; and

In Figure 12, reference numerals 190 and 192 are added.

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A marked-up copy (Annotated Marked-up Drawings) is attached.

Entry of the amendments to the drawings and f the accompanying corrected formal drawings, and confirmation of the entry in writing in the next Office communication are respectfully requested.

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P56525RE**REMARKS**

This paper is filed pursuant to 37 CFR §41.50 in response to the *Decision On Appeal* decided on the 22<sup>nd</sup> of June 2007, reconsideration and re-examination are respectfully requested.

**Amendment of the Specification**

The specification is amended to expressly identify Applicant's disclosure of a "sidewall."

**Support for the Amendment of the Specification**

Figures 4 through 12 of Applicant's originally filed drawings illustrate, in detail, negative pressure air bearing sliders each constructed with an U-shaped air bearing platform that circumscribes a majority of negative pressure cavity 150 which is formed on principal surface 111. At least one of the rear ABS platforms 110c, 110d includes a sidewall 190 that is contiguous with side edge 192 of slider body 100 extending between lead edge 121 and rear 123, and generally obliquely to principal surface 111 as well as the major surfaces shown for the rear ABS platforms 110c, 110d. Figures 4 through 12 show a trailing, terminal sidewall 192 of at least one of the rear ABS platforms 110c, 110d is angularly inset from its junction with sidewall 190 and side edge 192.

Applicant notes that Merriam-Webster's *Webster's Third New International Dictionary of the English Language Unabridged*, defines a "sidewall" as "a wall forming the side of something ...." This definition is consistent with Applicant's use of "sidewall" in the text of the specification.

**Listing of the Claims**

Pursuant to 37 CFR §1.121(c), this listing of the claims, including the text of the claims,

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will serve to replace all prior versions of the claims, in the application.

### Amendment of the Claims

Claims 21, 41, 42, and 55 are amended in this paper.

### Status of the Claims

Claims 21 through 60 are pending in the application.

### Rejections of Pending Claims

1. Claims 21, 30 through 32 and 41 were rejected under 35 U.S.C. §102(e) are anticipated Nepela *et al.*, U.S. Patent No. 5.568.881. Applicant traverses this rejection for the following reasons.

Claims 21, 30 through 32 define structures with:

“a U-shaped air bearing platform ... defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms ... at least one of said not more than two separate air bearing platforms including a sidewall contiguous with one of said boundaries.”

This structure is wholly absent from Nepela '881. Accordingly, claims 21, 30 through 32 are not anticipated by Nepela '881.

Independent claim 41 defines, *inter alia*:

“said front edge and said rear edge together defining boundaries of said principal surface in said longitudinal direction of said slider; and

a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing

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platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively forming a first air bearing surface terminating said first side wall portion and forming a second air bearing surface terminating said second side wall portion, at least one of said not more than two separate air bearing platforms including a sidewall extending from one of said boundaries."

This structure is wholly absent from Nepela '881. Accordingly, claim 41 is not anticipated by Nepela '881.

**(IV). Rejection of Claims 21, 30-32 and 41 Under 35 U.S.C. §102(a) Over Nepela '981**

To the extent that Applicant disagrees with the findings of the Board as not being supported by substantial evidence of record, Applicant repeats the following observations drawn from the evidence already present in the record of this prosecution history.

The *Examiner's Response* appears to have not provided the modality for a demonstration of anticipation under 35 U.S.C. §102(a) requested by the Board,<sup>1</sup> and has instead attempted to attribute teachings of Nepela '981 about his "relief vents" 133 to "central recessed cavity 128", and about his side rails 112, 114, to the opposite legs of the inverted U-shaped center pad 108, thereby confusing the clarification requested by the Board. In essence, the *Examiner's Response* is believed to have failed to address the issue raised in Applicant's *Appeal Brief*, and summarily seeks to dismiss Applicant's analysis of the anticipation rejection by once again, albeit in different words, that "Applicant's references to the siderails (112, 114) are not on point." Instead, the Examiner raises four additional issues which Applicant addresses below.

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<sup>1</sup> *Ex parte Braeken*, 54 USPQ2d 1110 (Bd. Pat. App. & Int. 1999) provides an excellent modality for concisely demonstrating anticipation under 35 U.S.C. §§102(a) and (c).

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A. **The Examiner's Response to Clarification Request (Paper No. 20070226) Departs From the Express Teachings of Nepela et al. U.S. 5.568.981**  
Claims 21, 30, 31, 32 and 41 were previously rejected under 35 U.S.C. §102(a) and (e) as being anticipated by Nepela '981. 35 U.S.C. §102(a),<sup>2</sup> as well as §102(e),<sup>3</sup> require a determination of whether *the invention* was anticipated.

First, in Paper No. 20070226, the Examiner addresses *an invention* different from that defined by Applicant's claims 21, 30, 31 and 42, and also different from that taught by Nepela '981. Specifically, in a single sentence the Examiner endeavors to demonstrate anticipation of the second paragraphs of Applicant's independent claims 21 and 31,<sup>4</sup> by asserting that Nepela '981 discloses:

"a U-shaped air bearing platform (108) defining a negative pressure cavity (cavity which includes the space between the rail of the U-shaped air bearing platform which indeed provides a central recessed cavity that extends from the central pad to the trailing edge of the slider – e.g., see COL. 2, ll. 50-51) on said principal surface ... ."<sup>5</sup>

In point of fact, the citation of Nepela '981 advanced by the Examiner<sup>6</sup> does not discuss "a U-

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<sup>2</sup> 35 U.S.C. §102(a) reads, in part, "A person shall be entitled to a patent unless – (a) *the invention* was known or used by others in this or a foreign country, before *the invention* thereof by the applicant for patent ... ."

<sup>3</sup> 35 U.S.C. §102(e) reads, in part, "A person shall be entitled to a patent unless – (a) *the invention* was described in ... (2)an application for patent by another filed in the United States before the invention by the applicant for patent ... ."

<sup>4</sup> Applicant notes that piecemeal anticipation as advanced by Paper No. 20070226 does not meet the standard for anticipation of *the invention* required by any paragraph of 35 U.S.C. §102.

<sup>5</sup> Paper No. 200700226, page 5, last four lines.

<sup>6</sup> Nepela '981, column 2, lines 50 and 51.

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shaped air bearing platform (108)”;<sup>7</sup> moreover, this citation of Nepela ‘981 advanced by the Examiner<sup>8</sup> does not, as is advocated by the Examiner, discuss “a U-shaped air bearing platform (108) *defining a negative pressure cavity* (cavity which includes the space between the rails of the U-shaped air bearing platform which indeed provides *a central recessed cavity that extends from the central pad to the trailing edge of the slider ... on said principal surface ...*”<sup>9</sup>

Instead, and in contradiction to the foregoing insertions set forth in Paper No. 20070226, the complete passage of Nepela ‘981 cited by the Examiner teaches that,

“**Relief vents** are formed between the two side rails and the central pad and extend from the slider leading edge to connect to a central recessed cavity that extends from the central pad to the trailing edge of the slider.”<sup>10</sup>

In annotated form, this passage of Nepela ‘981 would read:

“**Relief vents 133**<sup>11</sup> are formed between the two side rails **112, 114**<sup>12</sup> and the central pad **108**<sup>13</sup> and extend from the slider leading

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<sup>7</sup> Paper No. 200700226, page 5, last four lines.

<sup>8</sup> Nepela ‘981, column 2, lines 50 and 51.

<sup>9</sup> Paper No. 200700226, page 5, last four lines.

<sup>10</sup> Nepela ‘981, column 2, lines 50 and 51.

<sup>11</sup> Nepela ‘981 does not discuss his relief vents 133 either in conjunction with Figure 5a, or in conjunction with Figures 5b through 5d.

<sup>12</sup> Nepela ‘981 does not discuss the particulars of his embodiment shown in Figure 5c; Applicant that therefore, taken the liberty of referring the component parts of other Figures of Nepela ‘981 which are discussed by Nepela ‘981.

<sup>13</sup> Nepela ‘981, column 5, line 62, “wherein the center pads 106, 108, 110 are modified to accommodate different skew/velocity ranges for different applications used with negative pressure air bearing sliders of the instant invention.”

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edge 21<sup>14</sup> to connect to a central recessed cavity 128<sup>15</sup> that extends from the central pad 108<sup>16</sup> to the trailing edge (?)<sup>17</sup> of the slider.”<sup>18</sup>

In short, and contrary to the clarification advanced by the Paper No. 20070226, the passage advocated by the Examiner describes the relief vents 133 of Nepela ‘981, rather than Nepela ‘981’s central recessed cavity 128.<sup>19</sup> Consequently, Nepela ‘981 does not make an express teaching of Applicant’s “U-shaped air bearing platform defining a negative pressure cavity on said principal surface”<sup>20</sup>

Second, Applicant further notes that although Figures 2b, 3c, 4d and 5c all show substantially identically shaped, inverted U center pads 48, 68, 102 and 108 respectively, Nepela ‘981 does not explain or ascribe any particular function or characteristic to these inverted U-shapes.

Third, the subsequent passage of the single sentence written in Paper No. 20070226 to address the penultimate paragraphs of claims 21 and 31, shifts the object of the sentence from

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<sup>14</sup> Nepela ‘981, column 5, lines 17 and 18.

<sup>15</sup> Nepela ‘981, column 6, lines 7 and 8, to wit, and referring to Figure 5a, “A central negative pressure region 128 that is aft of the center pad 104 ... .”

<sup>16</sup> Nepela ‘981, column 5, line 62.

<sup>17</sup> Nepela ‘981 is believed to have not labeled the “trailing edge of the slider” with a reference symbol.

<sup>18</sup> Nepela ‘981, column 2, lines 50 and 51.

<sup>19</sup> Nepela ‘981, column 6, lines 7 and 8, to wit, and referring to Figure 5a, “A central negative pressure region 128 that is aft of the center pad 104 ... .”

<sup>20</sup> Applicant’s independent Claims 21 and 31, penultimate paragraphs.



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the “U-shaped air bearing platform (108)” to “two separate air bearing platforms.”<sup>21</sup> In particular, Paper No. 20070226 argues that Nepela ‘981 discloses:

“a U-shaped air bearing platform (108) defining a negative pressure cavity (cavity which includes the space between the rail of the U-shaped air bearing platform which indeed provides a *central recessed cavity that extends from the central pad to the trailing edge of the slider* – e.g., see COL. 2, ll. 50-51) on said principal surface”<sup>22</sup>,

and then shifts objects of that sentence, by asserting:

“said U-shaped air bearing platform comprising not more than two separate air bearing platforms (e.g. the [unnumbered] left side leg of the U-shaped air bearing as seen in FIG. 5c and the [also unnumbered] right side leg of the U-shaped air bearing as seen in FIG. 5c – the platforms joined by a cross-rai extending normal to the longitudinal direction of the slider), said platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination (see Examiner’s marked-up copy of FIG. 5c, appended herewith), at least one of said not more than two separate air bearing platforms including a side wall portion (e.g., vertical wall surface extending from the air-bearing platforms including a side wall portion (e.g., vertical wall surface extending from the air-bearing surface of the air bearing platform 1 or 2, to the bottom principal surface) ... ”<sup>23</sup>

In point of fact, this latter portion of the Examiner’s single sentence finds no support in the text of Nepela ‘981. In contradistinction to this fanciful description of central pad 108, Nepela ‘981 teaches that,

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<sup>21</sup> Nepela ‘981 identifies these “two separate air bearing platforms” with reference numerals 112, 114.

<sup>22</sup> Paper No. 200700226, page 5, last four lines.

<sup>23</sup> Paper No. 200700226, pages 5 and 6.

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"The negative pressure air bearing slider has two side rails providing *air bearing surfaces* extending *fully* from the leading edge towards the trailing edge of the slider, and a central pad at the leading edge for providing an additional *air bearing surface*."<sup>24</sup>

In other words, and in contradistinction to Applicant's "not more than two separate air bearing platforms",<sup>25</sup> by his express teachings, Nepela '981 teaches three *air bearing surfaces*.<sup>26</sup> Consequently, on this single point, Nepela '981 fails to anticipate *the inventions* defined by either of claims 21 or 31.

Fourth, in Paper No. 20070226, the Examiner then endeavors to erroneously identify Nepela '981's "center pad 108" as Applicant's "cross rail portion", despite the fact that Nepela '981 fails to identify any "cross-rail portion" or to use the phrase "cross rail portion";<sup>27</sup> endeavors to confine Nepela '981's central negative cavity 128 shown in Figure 5a,<sup>28</sup> to the

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<sup>24</sup> That is, in terms of Figure 5c, Nepela '981 teaches two separate *air bearing surfaces* provided by side rails 112 and 114, and a third *air bearing surface* provided by center pad 108..

<sup>25</sup> Applicant's claim 21, line 10, and claim 31, line 9.

<sup>26</sup> Nepela '981, column 2, lines 50 and 51.

<sup>27</sup> Independent Claims 21 and 31 do not use the phrase "cross rail", while dependent claim 32 defines Applicant's "cross rail portion extending generally laterally *across* said principal surface." Nepela '981 does not use the term "cross rail" and can not be read as suggesting Applicant's "cross rail portion extending generally laterally *across* said principal surface" because Nepela '981 depends upon its *raison d'être* of "In keeping with this invention, relief bents 30 are formed *between* the side rails 10, 12 and the central pad 8 and extend from the leading edge of the slider to contact the negative pressure cavity 18." Col. 3, lines 54-58.

<sup>28</sup> Nepela '981 does not discuss the particulars of his embodiment shown in Figure 5c; Applicant that therefore, taken the liberty of referring the component parts of other Figures of Nepela '981 which are discussed by Nepela '981.

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minuscule region defined by Column 5, lines 59-60 of Nepela '981; and endeavors to label in the Attachment A, "the vertical wall surface extending from the air-bearing surface of the air bearing platform 1 or 2, to the bottom principle [sic] surface" (*see the Examiner's comments, on page 6, first paragraph as 'sidewall portion' which the Examiner labeled in his Attachment A*). It seems that the subject matter Nepela '981 and Applicant's pending claims are classified in class 360 at subclass 235.9, as "rear side edge detail", and that the Examiner has ignored the fact that no reference currently classified in that subclass, or apparently no reference classified in the entirety of class 360 defines the term "sidewall."

It also seems that Applicant is the sole U.S. patent (see Applicant's parent U.S. 5,917,679 patent in column 6, at lines 37 and 38) to define the term "sidewall." This is significant because Nepela '981 depends upon the gaps between his center pad 108 and his side rails 112, 114. Nepela '981 also depends upon the presence of "negative pressure cavities 128c that are associated with each side rail 112, 114" (*see Nepela '981 at column 5, lines 57-60*), as well as "side reliefs 126" collectively, in order to ensure longitudinal symmetry characteristics, minimized sensitivity of flying height variation, and minimum roll and roll variation. Side reliefs 126 negate the presence of Applicant's side wall portion.

In essence, the Examiner has improperly mislabeled the center pad 108 of Nepela '981 as your client's cross rail, despite the fact that Nepela '981 clearly depends upon gaps 133 adjoining center pad 108, and does not assert that he teaches any "cross rail", and despite the fact that modification of side rails 112, 114 of Nepela '981 as illustrated in your client's Figures 6a, b would tend to minimize or eliminate "negative pressure cavity 128c that are associated with

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each side of 112, 114" of Nepela '981's Figure 5c.

## V. NEW GROUNDS OF REJECTION

(1)

### *New Ground of Rejection of Claims 42-51*

Reissue claims 42-51 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

As to claim 42, lines 11-13 (Br. 59) read as follows:

"said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending from different and facing spaced-apart opposite ends of said not more than two separate air bearing platforms..."

This does not make sense as the "separate air bearing platforms" extend from opposite ends of themselves. Also lines 14 and 15 of claim 42 recite "said first side wall portion" and "said second side wall portion" respectively. These items have no antecedent basis. Thus, it is unclear what structure Applicants are actually claiming in claim 42 and its dependent claims. The Board rejected of claims 42-51 under 35 U.S.C. § 112 under 37 C.F.R. § 41.50(b).

Claim 42 is amended to delete the clause "from different and facing spaced-apart opposite ends of said not more than two separate air bearing platforms." This removes the instance of indefiniteness averred cited by the Board as the basis for its rejection.

(2)

### *New Ground of Rejection of Claims 21, 30-32 and 41*

Reissue claims 21, 30-32, and 41 are rejected under 35 U.S.C. §102(b) as being anticipated by each of the Ogishima, Strom I, and Dorius patents. See Findings of Fact 42-47. Applicant respectfully traverses these rejections for the following reasons.

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Claims 21 and 31 define, albeit in different terms,

“a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion ... said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body ... .”

In contradistinction, Ogishima '184 teaches a structure with surfaces 26a, 26b separating surface 24 from both front and rear edges, while Strom U.S. 4,802,042 teaches that area 36 and side vent groove 38 to separate the surface of recessed cavity 22 from a rear edge.

Claims 21 and 31 also, and again using different language, define:

“an U-shaped air bearing platform circumscribing a majority of said principal surface while defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination to form trailing terminal ends of said negative pressure cavity spaced-apart from said rear portion, at least one of said not more than two separate air bearing platforms including a sidewall contiguous with one of said boundaries ... .”

Dorius *et al.* U.S. 5,438,467 teaches an air bearing with rails 104, 105 spaced-apart from side edges 112, 113. Accordingly, neither Ogishima '184, Strom '042 nor Dorius *et al.* '467 anticipate claims 21, 30 through 32 or 41.

(3)

Reissue claims 21, 30-32, and 41 are rejected under 35 U.S.C. §102(e) as being

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anticipated by the Ruiz patent. See Findings of Fact 48-49. For the reasons *supra*, the Board rejected of claims 21, 30-32 and 41 under 35 U.S.C. § 102(b) and (e) under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Claims 21 and 31 define, in different terms,

“a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion ... said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body ... .”

In contradistinction, Ruiz teaches a structure with rails 290 separating central region from the front edge of the body of slider 72. Accordingly, there is no anticipation of claims 21, 30 through 32 and 41 under either 35 U.S.C. § 102(b) or 35 U.S.C. § 102(e).

(4)

*New Ground of Rejection of Claims 21-23 and 31-34*

Reissue claims 21-23 and 31-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by the Bolasna I patent. See Finding of Fact 50-51. For those reasons *Supra*, the Board rejected of claims 21-23 and 31-34 under 35 U.S.C. § 102(e) under 37 C.F.R. § 41.50(b).

Bolasna U.S. 5.650.893 shows, in the Figure 5A cited by the Board in support of its rejection, a slider constructed with rails 62, 64 with rail 64 separating the surface of recessed section 68 from any boundary defined by leading edge 70 and trailing edge 72.

In contrast, claims 21 and 31 defines structures with “said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body.” Consequently, leading edge 70 and trailing edge 72 of Bolasna ‘893 can not be read as teaching Applicant’s “said front edge and said rear edge **together defining boundaries** of said principal surface **in a longitudinal direction** of said slider body.” At best, Bolasna ‘893

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suggests "leading edge 70 and trailing edge 72 separately defining a single longitudinal boundary of the surface of recessed section 68 "in said first direction." Accordingly, there is no anticipation.

(5)

*New Ground of Rejection of Claims 21, 31-32, 52-53, 55-56 and 58-59*

Reissue claims 21, 31-32, 52-53, 55-56 and 58-59 are rejected under 35 U.S.C. § 102(e) as being anticipated by the Lairson patent. See Findings of Fact 52-53. For the reasons *supra*, the Board rejected of claims 21, 31-32, 52-53, 55-56 and 58-59 under 35 U.S.C. § 102(e) under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

The rejected claims defines, in alternative structures,

"a plurality of arcuately shaped arms each having distal ends extending from opposite ones of said longitudinal sides curving inwardly across said central portion of said principal surface with spaced-apart proximal facing ends of said arms together forming a U-shaped air bearing platform located between said boundaries to separate a negative pressure cavity defined by said arms on said principal surface from said boundaries ... ."

This structure is wholly absent from Lairson U.S. 5,822,153. Accordingly, there is no anticipation.

(6)

*New Ground of Rejection of Claims 21-23, 30-34 and 41*

Reissue claims 21-23, 30-34 and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by the Chang patent. See Findings of Fact 54-55. For the reasons *Supra*, the Board rejected claims 21-23, 30-34 and 41 under 35 U.S.C. § 102(e) under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Both of Applicant's independent claims 21 and 31 define relations between the boundaries defined by the front edge and the rear edge, and the air bearing platforms. These

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relations are absent from Chang '634. Consequently, there is no anticipation.

(7)

*New Ground of Rejection of Claims 25-26 and 36-37*

Reissue claims 25-26 and 36-37 are rejected under 35 U.S.C. § 103 as being unpatentable over the Chang and Chapin patent.

An invention that would have been obvious is not patentable. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. At 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395. In particular, the Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court stated that there are "[t]hree cases decided after *Graham* [that] illustrate this doctrine." *Id.* at 1739, 82 USPQ2d at 1395. "In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at 1739-40, 82 USPQ2d at 1395. "In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, ... [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation." *Id.* at 1740, 82 USPQ2d at 1395. "[I]n *Sakraida v. AG Pro, Inc.*, ... the Court derived from the precedents the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such as

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arrangement, the combination is obvious.” *Id.* at 1740, 82 USPQ2d at 1395-96 (internal quotation omitted). The principles underlining these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art is obvious.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740, 82 USPQ2d at 1396. The operative question is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

See Findings of Fact 54-55, 58, 65 and 67-69. Given, the teachings of Chang and Chapin, the level of skill in the art, and small difference between Chang and the subject matter of claims 25-26 and 36-37, the Board concluded that the substitution of a recessed step (as found in Chapin) in place of the centered gap taught by Chang would have been obvious. For the reasons *supra*, the Board rejected of claims 25-26 and 36-37 under 35 U.S.C. § 103 under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Both of Applicant’s parent independent claims 21 and 31 define relations between the boundaries defined by the front edge and the rear edge, and the air bearing platforms. These relations are absent from the proposed combination of Chang ‘634 and Chapin U.S. 5.210.666. Moreover, the proposed combination is wholly devoid of Applicant’s definition of structures with “said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body.” Consequently, the Examiner’s proposed combination can not be read as teaching Applicant’s “said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body.” Accordingly, there is no *prima facie* showing of obviousness.

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(8)

*New Ground of Rejection of Claims 21-22, 24, 30-33, 35 and 41*

Reissue claims 21-22, 24, 30-33, 35 and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by the Bolasna II patent. See Findings of Fact 56-57. For the reasons *supra*, the Board rejected of claims 21-22, 24, 30-33, 35 and 41 under 35 U.S.C. § 102(e) under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Bolasna U.S. 5.870.250 is wholly devoid of Applicant's definition of structures with "said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body." Consequently, the Examiner's proposed combination can not be read as teaching Applicant's "said front edge and said rear edge **together defining boundaries** of said principal surface in a longitudinal direction of said slider body." Accordingly, there is no anticipation.

(9)

*New Ground of Rejection of Claims 25-26 and 36-37*

Reissue claims 25, 27, 36 and 37 are rejected under 35 U.S.C. § 103 as being unpatentable over the Bolasna II and Chapin patent.

See findings of Fact 56-58 and 66-69. Given, the teachings of Bolasna II and Chapin, the level of skill in the art, and small difference between Bolasna II and the subject matter of claims 25-26 and 36-37, the Board concluded that the substitution of a recessed step (as found in Chapin) in place of the off-center gap taught by Bolasna II would have been obvious. For the reasons *supra*, the Board rejected of claims 25, 27, 36 and 38 under 35 U.S.C. § 103 under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Both of Applicant's parent independent claims 21 and 31 define relations between the boundaries defined by the front edge and the rear edge, and the air bearing platforms. These relations are absent from the proposed combination of Bolasna '250 modified according to Chapin U.S. 5.210.666. Moreover, the proposed combination is wholly devoid of Applicant's

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definition of structures with "said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body." Consequently, the Examiner's proposed combination can not be read as teaching Applicant's "said front edge and said rear edge **together defining boundaries of said principal surface in a longitudinal direction of said slider body.**" Accordingly, there is no *prima facie* showing of obviousness.

(10)

*New Ground of Rejection so Claims 21, 28-32, 39-41 and 52-60*

Reissue claims 21, 28-32, 39-41 and 52-60 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Murray II patent. See Findings of Fact 59-60. For the reasons *supra*, the Board rejected of claims 21, 28-32, 39-41 and 52-60 under 35 U.S.C. § 102(b) under 37 C.F.R. § 41.50(b). Applicant respectfully traverses this rejection for the following reasons.

Applicant's independent claims 21, 31, 52, 55 and 58 define relations between the boundaries defined by the front edge and the rear edge, and the air bearing platforms. These relations are absent from Murray U.S. 5,406,432. Accordingly, there is no anticipation.

## IX. CONCLUSION


The feature attacked by the Examiner is only Applicant's "U-shaped air bearing platform", which defines specific air bearing surfaces, and does not purport to either define or exclude other air bearing surfaces upon the principal surface. What Nepela '981 lacks is this specific U-shaped air bearing platform. The ability of claims 21 and 31 to read upon other sliders which have air bearing platforms located at other parts of the principal surface is irrelevant to the question of whether centerpad 108 anticipates Applicant's U-shaped air bearing platform, as defined by claims 21 and 31. The Examiner has incorrectly considered only isolated limitations in Applicant's definition, and has failed to consider Applicant's definition of the U-shaped air bearing platform in its entirety. In view of the inability of Nepela '981 to meet the entirety of these features of Applicant's U-shaped air bearing platform, there is no anticipation.

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Applicant again concludes that the Examiner Staff has overlooked the express teachings of Nepela '981<sup>29</sup> which conclusively prevent "the leg portions"<sup>30</sup> of centerpad 108 from being read upon Applicant's U-shaped air bearing platforms defined by claims 21 and 31. Given this express teaching by Nepela '981, the interpretation given to center pad 108 by the Examining Staff is technically at variance with Nepela '981, and that interpretation may not be used to support an assertion of anticipation under either 35 U.S.C. §102(a) or 35 U.S.C. §102(e). The Board is respectfully requested to refuse to sustain this rejection.

No fees are believed to be incurred by this response. Should other fees be incurred however, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees after concurrently notifying Applicant's undersigned attorney.

Respectfully submitted,

  
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<sup>29</sup> See, by way of example, the teachings of Nepela '981 in column 2, lines 44 through 46, which not only recognize that its "two side rails" are distinct and functionally different from the other air bearing surfaces, but attribute specific critical properties and functions to those "two side rails."

<sup>30</sup> *Examiner's Answer*, Paper No. 20, page 5.